

**AMENDMENTS TO THE DRAWINGS**

**-- Please amend the drawing sheets by adding new drawing sheets 5-6 illustrating FIGS. 7-9 --**

## **REMARKS**

### **I. Status of Prosecution**

This amendment is responsive to the Office Action dated May 14, 2008. The Office Action dated May 14, 2008 was responsive to the Response to Election of Species Requirement filed on 01/25/2008. Claim 4 has been cancelled by the applicant in view of the election of species requirement. However, the Examiner noted that claim 15 recites the same features as claim 4, except it is a system claim; therefore, claim 15 has been treated by the Examiner as non-elected and is not being examined under the merits. Claims 1-3, 5-14, and 16-20 are now pending.

### **II. Drawings**

The drawings were objected to under 37 CFR 1.83(a). The Examiner indicated that the drawings must show every feature of the invention specified in the claims. The Examiner asserted that the complete features of every claim, for example, claim 1: "designating an imaging order ... for a plurality of objects to be rendered", "printer output device", etc.; claim 2: every feature of steps (a-d); claim 6: "photocopy machine"; claim 7: "printer, which can communicate with computer"; claim 19: "signal-bearing media"; claim 20: "transmission media and recordable media", must be shown or the feature(s) canceled from the claim(s). The Examiner indicated that no new matter should be entered.

The Examiner further indicated that corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The Examiner also stated that any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The

Examiner further argued that the figure or figure number of an amended drawing should not be labeled as "amended." The Examiner also asserted that if a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. The Examiner also stated that additional replacement sheets may be necessary to show the renumbering of the remaining figures. The Examiner also indicated that the drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). Further, the Examiner indicated that if the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The Examiner also stated that the objection to the drawings will not be held in abeyance.

Applicant notes that the drawings have been amended, as indicated herein to include new FIGS. 7, 8 and 9. Replacement sheets 1-6 are included herewith in support of such amendments. Applicant submits that new matter has not been introduced by way of such amended drawings, which are consistent with and enabled by Applicant's specification, including Applicant's claims which form a part of the specification. Additionally, the specification has been amended in support of the amendments to the drawings and replacement sheets submitted herewith. As such, the Applicant submits that the aforementioned objection to the drawings has been traversed and respectfully requests that this objection be withdrawn.

### III. Claim Rejections – 35 USC § 102

#### Requirements for Prima Facie Anticipation

A general definition of *prima facie* unpatentability is provided at 37 C.F.R.

§1.56(b)(2)(ii):

A *prima facie* case of unpatentability is established when the information *compels a conclusion* that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability. (*emphasis added*)

"Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (citing *Soundsciber Corp. v. United States*, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.), *adopted*, 149 USPQ 640 (Ct. Cl. 1966)), *cert. denied*, 469 U.S. 851 (1984). Thus, to anticipate the applicant's claims, the reference cited by the Examiner must disclose each element recited therein. "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

To overcome the anticipation rejection, the applicant needs only demonstrate that not all elements of a *prima facie* case of anticipation have been met, *i.e.*, show that the reference cited by the Examiner fails to disclose every element in each of the applicants' claims. "If the examination at the initial state does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992).

**Harrington**

Claims 1, 3, 5, 7, 12, 14, 16, 18, and 19-20 were rejected under 35 U.S.C. 102(b) as being anticipated by Harrington, US 5,588,093.

Regarding claim 1, the Examiner asserted that Harrington discloses a method, comprising: designating an imaging order associated with a imaging data stream for a plurality of objects to be rendered (see column 5, line 13-column 6, line 14), wherein said imaging order determines color quality rendering thereof (see column 5, line 17-column 9, line 24); rendering text generated by said printer output device through said imaging data stream according to a pre-determined ink color (see column 1, lines 50-64; column 6, line 32-column 7, line 56; column 8, lines 25-64); and generating, utilizing said imaging data stream, imaging separations based on an actual specified color for rendering thereof via a printer output device (see column 5, line 39-column 7, line 56; column 8, lines 25-64).

Regarding claim 3, the Examiner argued that Harrington further discloses applying a full color-imaging model to said imaging data stream to provide an enhanced approximation of a user-intent point of view (see column 2, lines 19-21; column 6, line 32-column 7, line 56; column 10, lines 40-48).

Regarding claim 5, the Examiner asserted that Harrington further discloses rendering colors of more than one hue on at least a single page utilizing said imaging data stream (see column 8, line 25-column 10, line 18).

Regarding claim 7, the Examiner argued that Harrington further discloses wherein said printer output device comprises a printer, which can communicate with a computer (see column 4, lines 39-58).

Regarding claims 12, 14, 16, 18, the Examiner argued that claims 12, 14, 16, 18 recite identical features, as claims 1, 3, 5, 7 except claims 12, 14, 16, 18 are system claims. The Examiner also asserted that arguments made for claims 1, 3, 5, 7 are applicable for claims 12, 14, 16, 18.

Regarding claim 19, the Examiner argued that Harrington further discloses wherein said imaging order module further comprises signal-bearing media (see column 10, lines 49-65, note that chip is a signal-bearing media and also the

portable source code being on a signal-bearing media is both well-known and commonly used in the art).

Regarding claim 20, the Examiner asserted that Harrington further discloses wherein said signal-bearing media further comprises at least one of the following: transmission media and recordable media (see column 10, lines 49-65, note that a chip is a transmission media, and also the portable source code being on a signal-bearing media – a transmission and recordable medium is again well-known and commonly used in the art).

The Applicant respectfully disagrees with this assessment. Claims 1, 3, 5, 7, 12, 14, 16, 18 and 19-20 include either directly or indirectly all of the following claim limitations:

designating an imaging order associated with a imaging data stream for a plurality of objects to be rendered, wherein said imaging order determines color quality rendering thereof;

applying said imaging order to said plurality of objects, including overlapping objects thereof, wherein said imaging order comprises:

(a) calling out all fills in an imaging data stream from resource;

(b) calling out text and logo data in an imaging data stream from resource;

(c) calling out all image data in an order in which such data appear and are called out from a variable data portion of said imaging data stream; and

(d) referencing a plurality of logos associated with said imaging data stream;

rendering text generated by said printer output device through said imaging data stream according to a pre-determined ink color; and

generating, utilizing said imaging data stream, imaging separations based on an actual specified color for rendering thereof via a printer output device.

The Harrington reference does not disclose each and every one of these claim limitations. Thus, because Harrington does not disclose all of the features, it follows that a *prima facie* case of anticipation under 35 U.S.C. 102 has not been established. Thus, the Applicant has demonstrated that not all elements of a *prima facie* case of anticipation have been met, *i.e.*, has shown that the reference cited by the Examiner fails to disclose every element in each of the applicants' claims. Based on the foregoing, the Applicant respectfully requests that the rejection to

claims 1, 3, 5, 7, 12, 14, 16, 18 and 19-20 be withdrawn and that such claims allowed.

#### **IV. Claim Rejections – 35 USC § 103**

##### ***Requirements for Prima Facie Obviousness***

The obligation of the examiner to go forward and produce reasoning and evidence in support of obviousness is clearly defined at M.P.E.P. §2142:

"The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

The U.S. Supreme Court ruling of April 30, 2007 (*KSR Int'l v. Teleflex Inc.*) states:

"The TSM test captures a helpful insight: A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. Although common sense directs caution as to a patent application claiming as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does."

"To facilitate review, this analysis should be made explicit."

The U.S. Supreme Court ruling states that it is important to identify a *reason* that would have prompted a person to combine the elements and to make that analysis *explicit*. MPEP §2143 sets out the further basic criteria to establish a *prima facie* case of obviousness:

1. a reasonable expectation of success; and
2. the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined).

It follows that in the absence of such a *prima facie* showing of obviousness by the Examiner (assuming there are no objections or other grounds for rejection) and of a *prima facie* showing by the Examiner of a *reason* to combine the references, an applicant is entitled to grant of a patent. Thus, in order to support an obviousness rejection, the Examiner is obliged to produce evidence compelling a conclusion that the basic criterion has been met.

### **Harrington**

Claims 6 and 17 were rejected under 35 U.S.C. 103 as being unpatentable over Harrington, US 5,588,093 in view of well known art.

Regarding claim 6, the Examiner admitted that Harrington fails to explicitly disclose wherein said printer output device comprises a photocopy machine.

The Examiner asserted, however, that "Official Notice" is taken to note that multi-function peripherals (MFPs) or a printer output device comprising a photocopy machine are notoriously well known and commonly used in the art. The Examiner argued that it would have been obvious to include a MFP or printer with photocopy functionality as a printing system in the apparatus of Harrington for the benefit of providing increased user flexibility and options.

Regarding claim 17, the Examiner asserted that claim 17 recites identical features, as claim 6, except claim 17 is a system claim. The Examiner stated that arguments made for claims 6 are applicable for claim 17.

Applicant respectfully disagrees with this assessment and notes that claims 6 and 17 respectfully depend from amended claims 1 and 12 which include all of the following claim limitations:

designating an imaging order associated with a imaging data stream for a plurality of objects to be rendered, wherein said imaging order determines color quality rendering thereof;

applying said imaging order to said plurality of objects, including overlapping objects thereof, wherein said imaging order comprises:

(a) calling out all fills in an imaging data stream from resource;

(b) calling out text and logo data in an imaging data stream from resource;

(c) calling out all image data in an order in which such data appear and are called out from a variable data portion of said imaging data stream; and



(d) referencing a plurality of logos associated with said imaging data stream;  
rendering text generated by said printer output device through said imaging data stream according to a pre-determined ink color; and  
generating, utilizing said imaging data stream, imaging separations based on an actual specified color for rendering thereof via a printer output device.

The Harrington reference does not teach each and every one of these claim limitations. Additionally, "Official Notice" also does not teach or suggest all such claim limitations including the features of claims 6 and 17. Based on the foregoing, the Applicant submits that the rejection to claims 6 and 17 has been traversed. Applicant respectfully requests allowance of claims 6 and 17.

#### **V. Allowable Subject Matter**

Claims 2 and 13 were objected to as being dependent upon a rejected base claim, but the Examiner indicated that they would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant notes that claims 2 and 13 have been cancelled and the former claim limitations of claims 2 and 13 respectively incorporated into claims 1 and 12 via amendments. It follows that claims 1 and 12 constitutes a rewritten independent form of claims 1, 2 and 12, 13, thereby including all claim limitations of the base claims 1 and 12 and dependent claims 2, 13. Applicant notes that there were no intervening claims between claims 1 and 2 and claims 12 and 13. As such Applicant submits that claims 1 and 12 are now in an allowable format and that any claims depending from claims 1 and 12 should also be allowed.

The Examiner also stated claims 8-11 are allowable over the prior art.

The following is the Examiner's statement of reasons for the indication of allowable subject matter: The prior art of record does not disclose, teach, or suggest the claimed inventions of (in combination with all other limitations in the claims), (a) calling out all fills in an imaging data stream form resource; (b) calling out text and logo data in an imaging data stream form resource; (c) calling out all

image data in an order in which such data appear and are called out from a variable data portion of said imaging data stream; and (d) referencing a plurality of logos associated with said imaging data stream as set forth in claims 2, 8, and 13. Claims 9-11 are dependent upon claim 8 and further limit the claimed invention.

**VI. Conclusion**

In view of the foregoing discussion, the Applicant has responded to each and every rejection of the Official Action. Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact the undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,



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